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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,168	02/19/2002	Junji Momoda	SPO-587/DIV	1894

7590 09/29/2003
SHERMAN & SHALLOWAY
413 North Washington Street
Alexandria, VA 22314

EXAMINER

SMALL, ANDREA D SOUZA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 09/29/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,168

Applicant(s)

MOMODA ET AL.

Examiner

Andrea D Small

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/762,112.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

I. Preliminary Matters:

(a) Applicants claim of priority to 09/762,112, now abandoned, and further under 371 of PCT/JP00/03458, which claims priority to JAPAN 156270/99 and JAPAN 205166/99 is acknowledged. The priority papers were provided in 09/762,112.

(b) Preliminary amendment filed 2/19/2002 has been received and entered into the file.

(c) Claims 1-18 are pending.

II. Restriction:

Restriction is required under 35 U.S.C. 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group I, claim(s) 1-3, drawn to photochromic material according to the formula in claim 1.

Group II, claim(s) 4-6, drawn to photochromic optical material according to the formula in claim 1.

Group III, claim(s) 7-9 and 13-15, drawn to photochromic polymerizable composition containing the compound according to the formula in claim 1.

Group IV, claim(s) 10-12 and 16-18, drawn to photochromic polymerizable composition containing the compound according to the formula in claim 1 and a polymerizable initiator.

PCT Rule 13.1 states that the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (requirement of unity of invention).

PCT Rule 13.2 state that unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

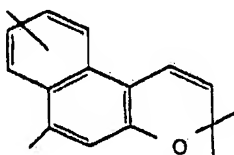
Annex. B, Part 1(b), provides that "special technical features" mean those technical features, which, as a whole, define a contribution over the prior art.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

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The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical features that can be taken, as a whole with all the groups is the chromene compound as depicted below.



These features were known in the art prior to the filing of the instant application, therefore do not provide a contribution over the art and thus cannot be considered to be a 'special technical feature' within the definition of the same under PCT rules 13.1 and 13.2. Consequently, unity of invention is lacking.

This application contains claims, such as claim 1, 2, and 3, which are directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 for the same reasons as discussed supra.

Therefore,

The above cited groups, therefore, must be further restricted because patentably distinct species may be included together in a generic claim where the number of species is *reasonable*. Accordingly, along with the election of one of the above groups, the following action is also taken.

It is to be noted that the following action is a restriction requirement placed on the instant claims; they are NOT being rejected as being an improper Markush claim. The entire contents of

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the claims will eventually be examined, either as elected subject matter in the instant application or as elected subject matter in divisional applications.

These claims are generic to a plurality of disclosed patentably distinct species comprising, for example, the compounds falling within the generic formula in claim 1, 2 or 3, wherein the morpholine at the R1 position of compound, may be classified in class 544, subclass 106; the indole moiety at the R1 position of compound is classified in class 548, subclass 350, etc. Each of these species differs one from the other in structure, element, molecular formula, process of preparing, chemical interaction, etc., resulting in each of these species having acquired a separate status in the art. Examining this plurality of distinct species in the same application would result in a serious burden during examination.

The search required, both electronic and manual database, for each of the patentably distinct species is separate and involves separate search considerations and search strategies. These searches are not co-extensive and the evaluation of the search results are divergent, so much so that searching for a reference that would anticipate a reasonably grouped invention, say for example, the morpholine species, would not even render the non-elected invention, say for example the indole species, obvious. Therefore, a serious burden would be placed on the office if restriction within these generic claims were not required.

A precise listing of all the possible sub-groups of inventions that would fall under any of the above main invention groups, identified supra, cannot be made due to the sheer volume of species encompassed by the instant claims. Consequently, Applicant is required to elect a single disclosed species or single preferred embodiment of their invention, even though this

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requirement is traversed. Additionally, whatever specific compound is ultimately elected, applicants are required to list all claims readable thereon.

Upon the election of a single disclosed species (e.g. Example, page number and structural depiction) or a preferred embodiment of the invention, a sub-group, inclusive of the elected species, will be identified by the Examiner for examination. This sub-group will establish the elected group to be examined and the remaining subject matter not within the confines of the sub-group will be withdrawn as non-elected subject matter. This remaining non-elected subject matter may then be pursued in divisional applications as is Applicants right under 37 CFR 1.142(b).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i)

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

III. Contact Information:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to

Andrea D. Small whose telephone number is (703) 305-0811.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:30-6:30 PM. The number for accessing the facsimile machine is (703) 746-4984.

Andrea D. Small, Esq.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

September 24, 2003